REMARKS

Claims 24 and 25 are added, and therefore claims 12 to 25 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraphs two and four (2, 4) of the Final Office Action, claim 23 was rejected under the first paragraph of 35 U.S.C. § 112, as to the written description requirement.

While the rejection may not be agreed with, to facilitate matters, claim 23 has been rewritten to better clarify the claimed subject matter. Support for claim 23, as presented, may be found in the Substitute Specification, e.g., at page 5, lines 14 to 18, which explicitly recites "cover[ing] the electrical losses occurring during conversion of the drive power, without loading the battery."

As further regards the written description requirement, the Office bears the initial burden of presenting "evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims" -- and not merely a list of terms that the Office does not understand. (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). In particular, the Manual of Patent Examining Procedure specifically provides that if the Office rejects a claim based on the lack of a written description, the examiner should "identify the claim limitation not described" and also provide "***reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application***." (See id.).

It is respectfully submitted that the Final Office Action's arguments and assertions simply do not identify why the rejected claims are not supported by the written description of the present application (and its specification) — which it plainly is, as explained herein.

In this regard, the Office Action does not explain why a person skilled in the art would not recognize the various features of claim 1 (including as a grammatical matter). The present application makes this plain to any person having ordinary skill (or any person for that matter).

As stated by the Board in Ex parte Harvey, 3 U.S.P.Q. 2d 1626, 1627 (Bd. Pat. App. Int. 1986) (emphasis added, citations omitted):

> **Compliance with the written description requirement of Section 112 only requires that appellant's application contain sufficient disclosure, *expressly or inherently*, to make it clear to persons skilled in the art that appellant possessed the subject matter claimed. The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the claimed subject matter, *rather than the presence or absence of literal support in the specification for the claimed language.***

Likewise, as stated by the Board in Ex parte Sorenson, 3 U.S.P.Q. 2d 1462, 1463 (Bd. Pat. App. Int. 1987) (emphasis added):

> **[W]e are mindful that appellant's specification need not describe the claimed invention in *ipsis verbis* to comply with the written description requirement. *The test is whether the originally filed specification disclosure reasonably conveys to a person having ordinary skill that applicant had possession of the subject matter later claimed. . . .* Moreover, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in appellant's specification disclosure a description of the invention defined by the claims.**

In particular, the Sorenson Board, noting that the examiner only essentially stated that the claim expressions at issue did not "appear in the original disclosure" and that the claim expressions were therefore "not adequately supported by the few specific compounds in the specification", found that the examiner had not met his initial burden of "presenting evidence why a person having ordinary skill in the art would not recognize in appellant's specification a description of the invention defined by the claims" — and that the "only reasoning presented" that the Board could discern was an "example of *ipse dixit* reasoning, resting on a bare assertion by the Examiner".

It is therefore respectfully submitted that the present application does satisfy the written description requirement of 35 U.S.C. § 112. Accordingly, it is respectfully submitted that the "written description" rejection of the claims should be withdrawn.

With respect to paragraphs three and four (3, 4) of the Final Office Action, claim 23 was rejected under the first paragraph of 35 U.S.C. § 112, as to the enablement requirement.

With respect to claim 23 being rejected as non-enabling under the first paragraph of 35 U.S.C. § 112, the rejection is not understood. In any event, as explained above, support for claim 23, as presented, may be found in the Substitute Specification, e.g., at page 5, lines 14 to 18, which explicitly recites "cover[ing] the electrical losses occurring during conversion of the drive power, without loading the battery." Accordingly, the enablement rejection is not understood and is plainly obviated by the foregoing.

Also in this regard, the Final Office Action's assertions and arguments presented simply do not reflect the standard for determining whether a patent application complies with the enablement requirement that the specification describe how to make and use the invention — which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d. 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is "whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." (See id. (citing United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is "improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors," and that the Office's analysis must therefore "consider all the evidence related to each of these factors" so that any nonenablement conclusion "must be based on the evidence as a whole." (See M.P.E.P. § 2164.01).

Also, the Office bears the initial burden of establishing why the "scope of protection provided by a claim is not adequately enabled by the disclosure." (See id. (citing In re

Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See id.).

In contrast to the above, however, the Final Office Action's unsupported assertions simply do not concern — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does, as evidenced, for example, by the above reference to the present application. In short, the Final Office Action's assertions are merely conclusory and do not address the issue of whether one having ordinary skill would have to unduly experiment to practice the claimed subject matter of the rejected claims — a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of Ex Parte Reese, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, the examiner's subjective belief was simply not supported by any "evidence or sound scientific reasoning" and therefore ignored recent case law — which makes plain that an examiner (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). Moreover, the Board made clear that it is "incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence," and also made clear that "[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific

reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph." (See id. at 1222 & 1223; italics in original). In the present case, the Final Office Action has merely alleged in a conclusory way that undue experimentation would be required. Moreover, even as to the assertions as presented, the present application plainly discloses how to use the subject matter of the rejected claims, as discussed above.

In view of all of the foregoing, it is plain that the Final Office Action's assertions to support the rejection of the claim simply do not satisfy the judicial standards discussed above with respect to the enablement requirement since the arguments and assertions presented do not relate the scope of the claim to the specification to determine whether the specification is enabling, nor do they properly address the enablement factors. It is therefore respectfully submitted that the Final Office Action has not even established a prima facie case as to the enablement requirement. It is therefore respectfully requested that the enablement rejection be withdrawn based on the foregoing.

With respect to paragraph five (5) of the Final Office Action, claim 23 was rejected as indefinite under the second paragraph of 35 U.S.C. § 112.

While the rejections may not be agreed with, to facilitate matters, claim 23 have been rewritten to better clarify the claimed subject matter. It is respectfully submitted that claim 23, as presented, now better complies with the definiteness requirement of the second paragraph of 35 U.S.C. § 112, and it is therefore respectfully requested that the rejections be withdrawn.

As regards the terms and phrases cited in the Office Action as indefinite and unclear, it is respectfully submitted that the cited terms and phrases are definite and clear as used and as would be understood when the rejected claim is read in view of the specification -- which is the proper objective standard.

It is respectfully submitted that the cited terms and phrases are therefore definite, especially to a person having ordinary skill in the art, in view of the foregoing, as well as the remainder of the specification.

In view of the above, it is respectfully submitted that the presently pending claims comply with the second paragraph of § 112 since a person having ordinary skill in the art would understand what is claimed when the claim is read in view of the specification. See

Miles Labs., Inc. v. Shandon, Inc., 997 F.2d 870, 27 U.S.P.Q.2d 123 (Fed. Cir. 1993). In this regard, it is also noted that terms in a claim are to be understood in view of the specification. (See *In re Weiss*, 26 U.S.P.Q.2d 1885, 1887 (Fed. Cir. 1993) (when interpreting a claim term or phrase, one must "look to the specification for the meaning ascribed to that term"; Board reversed) (unpublished decision); *In re Okuzawa*, 190 U.S.P.Q. 464, 466 (C.C.P.A. 1976) ("claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification"; Board reversed; emphasis in original) (citing *In re Royka*, 180 U.S.P.Q. 580, 582-83 (C.C.P.A. 1974) (claims are "not to be read in a vacuum" and "their terms still have to be given the meaning called for by the specification of which they form a part"; Board reversed; emphasis in original); and *In re Rohrbacher*, 128 U.S.P.Q. 117, 119 (C.C.P.A. 1960) (an "applicant is his own lexicographer and words used in his claims are to be interpreted in the sense in which they are used in the specification"; Board reversed)).

Approval and entry are respectfully requested, as is withdrawal of the indefiniteness rejection.

With respect to paragraph seven (7) of the Final Office Action, claims 12, 13, 18, 19, 21, and 22 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hara et al., U.S. Patent No. 5,713,814 (the Hara reference), or in the alternative, as unpatentable over the combination of the Hara reference and King, U.S. Patent No. 5,345,154 (the King reference).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated

reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the obviousness rejections may not be agreed with, to facilitate matters, claim 12 has been rewritten to provide the feature of "*selecting a characteristic map from a plurality of characteristic maps on the basis of a required electrical power by power consumers, distinct from an energy storage device, of an on-board electrical system.*" Support for this feature may be found in the Substitute Specification, *e.g.*, at page 2, line 16, to page 3, line 2; and page 5, line 30, to page 6, line 10. Specifically, the Substitute Specification at page 2, line 31, to page 3, line 2 clearly differentiates between the electrical power required by power consumers, and the electrical power demanded from or deliverable by the energy storage device. Further, in this regard, the M.P.E.P. states that "[i]f alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 U.S.P.Q. 187, 196 (C.C.P.A. 1977) ("[the] specification, having described the whole, necessarily described the part remaining.")." M.P.E.P. 2173.05(i).

In contrast, the Hara reference does not disclose (or even suggest) the feature of selecting a characteristic map from a plurality of characteristic maps based on *a required electrical power by power consumers, distinct from an energy storage device, of an on-board electrical system*, as provided for in the context of claim 12, as presented. The Final Office Action asserts that the "battery state of charge [is] understood to be inversely proportional to the power required by the battery to return the battery to a full charge." (Final Office Action, p. 3). Regardless of the accuracy of this assertion (which is not conceded by the Applicants), it is respectfully submitted that this assertion is inapplicable to the present claims. Specifically, the required electrical power by power consumers of claim 12 cannot be compared to the state of charge of the battery. As further described in the Substitute Specification, the method according to the presently claimed subject matter takes into consideration the required electrical power by power consumers, distinct from an energy storage device, of the on-board electrical system. Specifically, the Substitute Specification describes the electrical power required by power consumers (PVer) of the on-board electrical

system as distinct from the power reserve of the battery (PBat). (Substitute Specification, p. 6, lines 4 to 10). Thus, the required electrical power according to claim 12 is not the battery's state of charge, but rather that of power consumers, distinct from an energy storage device, of the on-board electrical system.

Although the Final Office Action at page 3 asserts that "battery state of charge ... is employed to select amongst a plurality of characteristic operating maps (e.g., figures 14, 15, 16 [of the Hara reference]," taking the state of charge into consideration is merely an additional feature of dependent claim 13, which is distinct from the electrical power required by power consumers of the on-board electrical system, as provided for in the context of claim 12, as presented.

By selecting a map based on the *required electrical power by power consumers, distinct from an energy storage device, of an on-board electrical system*, it is possible to set an operating point of the drive train so that electrical losses of the drive train during conversion of the drive power can be covered without charging or discharging the battery. (Substitute Specification, p. 5, lines 14 to 28). In stark contrast, the Hara reference instead refers to switching the operation point due to the battery's state of charge. Specifically, the Hara reference indicates that "a plurality of mode switching maps are provided to correspond to the residue of the battery," and also refers to switching modes "in accordance with the residue of the battery, as determined based upon the output of the battery residue detecting means." (Hara et al., col. 2, lines 66 to 67; and col. 4, line 66, to col. 5, line 30).

Further, Figures 14, 15, and 16 of the Hara reference merely refer to three mode switching maps, each corresponding to a particular battery residue: 60% to 85% residue, less than 60% residue, and greater than 85% residue. (Hara et al., col. 11, line 41, to col. 12, line 9).

The method according to the presently claimed subject matter is therefore wholly different than that of the Hara reference, which does not disclose (or even suggest) the feature of *selecting a characteristic map from a plurality of characteristic maps on the basis of a required electrical power by power consumers, distinct from an energy storage device, of an on-board electrical system*, as provided for in the context of claim 12, as presented.

Further, the Final Office Action at page 4 admits that the Hara reference "fails to explicitly teach that a battery state of charge is related to a power requirement." Therefore, it is plainly apparent that the system of the Hara reference, at best, may only refer to switching

maps based on the battery residue, and does not disclose (or even suggest) the feature of *selecting a characteristic map on the basis of a required electrical power by power consumers, distinct from an energy storage device, of an on-board electrical system*, as provided for in the context of claim 12, as presented.

Further, the King reference merely refers to estimating power losses from electric accessories. (King, col. 2, lines 64 to 67; and Figures 1 and 4). These estimated values are obtainable, and as explained in the Substitute Specification, "[i]t is disadvantageous that the power losses of electrical machines . . . are not considered at all or are merely considered as estimated values." (Substitute Specification, p. 2, lines 2 to 5). Thus, the King reference does not disclose the feature of *selecting a characteristic map on the basis of a required electrical power by power consumers, distinct from an energy storage device, of an on-board electrical system*, as provided for in the context of claim 12, as presented. Since the King reference does not cure the critical deficiencies of the Hara reference, the proposed combination of the Hara and King references does not disclose (or even suggest) all of the features of claim 12, as presented.

Accordingly, it is respectfully submitted that claim 12, as presented, is allowable over the Hara reference, or in the alternative, over the combination of the Hara and King references, for at least the reasons provided above. Claims 13, 18, 19, 21, and 22 ultimately depend from claim 12, and are therefore allowable for at least the same reasons as claim 12.

Withdrawal of the rejections of these claims is therefore respectfully requested.

With respect to paragraph eight (8) of the Final Office Action, claim 20 was rejected under 35 U.S.C. § 103(a) as unpatentable over the Hara reference, or alternatively, over the combination of the Hara and King references.

As explained above, the Hara reference does not disclose (or even suggest) all of the features of claim 12, as presented. As also explained above, the proposed combination of the Hara and King references also does not disclose (or even suggest) all of the features of claim 12, as presented. Accordingly, claim 12 is allowable, as is its dependent claim 20.

With respect to paragraph nine (9) of the Final Office Action, claims 14 to 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of the Hara reference and Yoshino et al., European Patent No. EP1142749 (the Yoshino reference), or alternatively, over the proposed combination of the Hara, King, and Yoshino references.

As explained above, the Hara reference does not disclose (or even suggest) all of the features of claim 12, as presented. As also explained above, the proposed combination of the Hara and King references also does not disclose (or even suggest) all of the features of claim 12, as presented. Since the Yoshino reference does not cure -- and is not asserted to cure -- the critical deficiencies of the Hara reference, or alternatively, the critical deficiencies of the proposed combination of the Hara and King references, the proposed combination of the Hara and Yoshino references, or alternatively, the proposed combination of the Hara, King, and Yoshino references does not disclose (or even suggest) all of the features of claim 12, as presented, so that claim 12 is allowable, as are its dependent claims 14 to 17.

Withdrawal of the rejections of these claims is therefore respectfully requested.

New claims 24 and 25 do not add any new matter and are supported by the present application. Claims 24 and 25 depend from claim 12,as presented, and are therefore allowable for at least the same reasons as claim 12, as presented.

In sum, it is respectfully submitted that claims 12 to 25 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. All issues raised having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

Dated: 10/20/2008

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